

REMARKS

Examiner has objected to the drawings under 37 CFR 1.83(a) and further notes that the drawings have not yet been reviewed by a PTO draftsman. In response, Applicant respectfully requests that Examiner's objections to the drawings be held in abeyance in order to later proceed with amended versions in full compliance following the draftsman's review.

Examiner has rejected Claims under 35 U.S.C. § 112 as being indefinite. In response, Applicant has amended Claims 1, 13, 16 and 18 per Examiner's recommendations as follows. Specifically, with respect to Claim 1, line 10, Applicant has inserted "second" after "said" for antecedent basis purposes and further has amended "the coincident display" to read "said display." With respect to Claim 13, Applicant has inserted "from said sleeve" in order to clarify what structure the circular cards are removable from. With respect to Claim 16, Applicant has removed "the coincident display" and has inserted "are coincidently visualized through said at least one viewing window." Lastly, with respect to Claim 18, Applicant has removed "the coincident display" and has inserted "coincidently" before the word "viewing."

Examiner has rejected Claims 1, 11, 12, 14, 15 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Galvin* (US 4,964,043).

In response thereto, Applicant respectfully traverses Examiner's rejections.

Galvin ('043) describes a "system for visualizing, identifying and ordering gearing configurations," wherein a series of rotationally adjustable displays enables the identification of complex interrelated technical requirements for the purpose of semi-automatedly narrowing down a vast variety of options to obtain a specific electronic reference for use in a digital computer system. See Col. 6, lines 11-16 and 49-51; Col. 1, lines 19-31. This is unlike Applicant's jewelry selection device, wherein the rotationally adjustable displays enable a plurality of jewelry design selections in order to expand options, not to narrow options. Applicant's device is utilized to provide a user with a means to visualize virtually endless jewelry design combinations, not to provide a user with a means to identify a specific, complex technical configuration.

Applicant respectfully disagrees with Examiner's assertion that the "platform having a first means and a second means" of *Galvin* ('043) renders Applicant's device obvious. "Distilling an invention down to the 'gist' or 'thrust' of an invention disregards the requirement of analyzing the subject matter 'as a whole.'" *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). The only similarity between Applicant's

invention and the device of *Galvin* ('043) is that each employs a rotational display component. The subject matter as a whole, however, is entirely different. The subject matter of *Galvin* ('043) is directed toward providing a relatively simple reference tool for identifying a specific interrelationship of numerous complex technical parts. The subject matter of Applicant's device is directed toward providing an interactive visualization tool for assisting in the design and selection of jewelry.

"To establish a *prima facie* case of obviousness...the prior art reference must teach or suggest all the claim limitations," MPEP 706.02(j), and *Galvin* ('043) does not teach a jewelry selection device, a display enabling viewing of jewelry selections, means for making selections from a plurality of jewelry selection components, nor coincident display of such components in order to view a selection. Thus, *Galvin* ('043) does not establish a *prima facie* case of obviousness.

Additionally, Examiner cites *In re Gulack*, 703 F.2d 1381, 217 USPQ 401 (Fed. Cir. 1983), stating that Applicant's "printed matter is not functionally related in a new or unobvious way to the substrate upon which it is located" and thus "does not distinguish the invention from the prior art." Applicant respectfully notes that, contrary to Examiner's assertions, the court in *In re Gulack* specifically stated that **"a printed matter rejection under § 103**

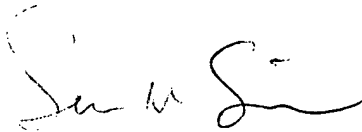
stands on questionable legal and logical footing," and that "differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter...the board **cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable.**" *In re Gulack*, 703 F.2d at 1385.

Applicant's printed matter is functionally related to the substrate. Like the indicia of *In re Gulack* and *In re Miller*, 418 F.2d 1392 (CCPA 1969), "there is a new and unobvious functional relationship between" Applicant's first component selection means, with the arrangement of the jewelry setting indicia thereon, and Applicant's second component selection means, with the arrangement of the stone indicia thereon, whereby the novel functional interrelationship of the structure and the indicia enables the selection and visualization of a jewelry design. Additionally, in *In re Gulack*, the structures were exactly the same. That is "the sole difference ... reside[d] in the content of the printed matter," yet the device was held to be patentable. *In re Gulack*, 703 F.2d at 1386. Not only is the content of Applicant's printed matter in no way related to that of *Galvin* ('043), the structure of Applicant's device has only very limited similarity in that each includes a rotationally carried component. Thus, Applicant respectfully asserts that his jewelry selection device is clearly patentable.

CONCLUSION

The above-made amendments are to form only and thus, no new matter was added. Applicant respectfully believes that, based upon the forgoing, the Claims and application in condition for allowance. Should the Examiner have any further questions and/or comments, Examiner is invited to telephone Applicant's undersigned Attorney at the number below.

Respectfully submitted, this 12th day of February, 2004.



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